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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/660,785	09/13/2000	Benjamin E. Hansen	1692	7918
20350	7590	01/13/2005	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834				FOSTER, ROLAND G
		ART UNIT		PAPER NUMBER
		2645		

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/660,785	HANSEN ET AL.
	Examiner	Art Unit
	Roland G. Foster	2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 August 2004.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,6-14 and 16-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4,6-14 and 16-25 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

**LED ACTION**

***Response to Arguments***

In the amendment, filed on August 19, 2004, the applicant argues that the examiner failed to establish a *prima facie* case of obviousness because the examiner failed to support his suggestion/motivation statement “beginning on page 5” of the last Office action (i.e., the motivation statement applying to independent claim 1 and by implication the remaining independent claims 11 and 23). Specifically, the applicant cites to MPEP § 2143 and 2143.03 and concludes that, because the examiner was relying on personal knowledge to supply a motivation that was traversed by the applicant, the examiner is required to provide documentary proof or an affidavit stating the facts within the personal knowledge of the examiner.

Applicant’s arguments were duly considered but are not deemed fully persuasive. The applicant relies upon MPEP § 2143.03, however this section of the MPEP refers to the taking of Official notice, which the examiner did not do in rejecting claims 1, 11, and 23. Therefore, the teaching of MPEP § 2143.03 are not relevant to the examiner’s rejection of claims 1, 11, and 23.

MPEP § 2143, although relevant, supports the examiner’s motivation statement. Specifically, MPEP § 2143 states that “teaching, suggestion, or motivation...[can be] found in...the references themselves or in the knowledge generally available to one of ordinary skill in the art.” Here, the examiner relied upon knowledge generally available to one of ordinary skill in the art of call screening systems, such as the benefits of routing an incoming call to voice mail

in cases where the called party would like to record a message from a caller rather than dedicating time to answer the call in real time. In another example, it would have been generally known that telephones are often coupled to voice messaging systems either locally (e.g., telephone answering devices) or at the network level (e.g., voice mail systems) and thus the simple option of routing an incoming call to another telephone device as disclosed by the base reference Shtivelman (U.S. Patent No. U.S. Patent No. 6,259,692 B1) would have provided an option to route the call to a coupled voice messaging system with very little structural modification required.

For the above reasons, the following rejections are repeated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-14, 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,259,692 B1 to Shtivelman et al. ("Shtivelman '692"), of record, in view of U.S. Patent No. 6,353,611 B1 to Norris et al. (Norris '611), of record.

With respect to claim 1, see the following paragraphs for details on how Shtivelman '692 discloses particular limitations within the claim.

The limitation "forwarding the called station telephone service to an application server upon connection of the called station to the data network" reads on Shtivelman '692 as follows. A subscriber places a call in order to log onto his Internet service provider (ISP) (connection to the data network) (Fig. 1 and col. 4, lines 55-60). Upon connection, subsequent calls to the subscriber's telephone 11 (called station telephone service) will be forwarded by telephony switch 151 to telephony switch (with IP interface) 141 (Fig. 1 and col. 4, line 67 – col. 5, line 3). The telephony switch (with IP interface) 141 provides subscriber services such as Internet call waiting (col. 5, lines 4-15) and thus can be considered an "application server."

The limitation "responsive to a telephone call from a calling station, forwarding the telephone call to the application server" reads on Shtivelman '692 as follows. When a caller at

telephone 16 places a call to the subscriber (col. 4, lines 47-54), the call is forwarded to telephony switch (with IP interface) 141 (application server) as discussed above.

The limitation "at the application server, obtaining from an Internet Access Server, an IP address relating to the called station, wherein the Internet Access Server is a different server from the application server" reads on Shtivelman '692 as follows. The telephone switch 141 (application server) obtains from an ISP (Internet access server) an IP address relating to the called station (col. 5, lines 28-36) where the telephone ISP 130 (Internet access server) is a different server from the switch 141 (application server).

The limitation "sending a query to the called station via the data network" reads on Shtivelman '692 as follows. When a caller at telephone 16 places a call to the subscriber (col. 4, lines 47-54), a call waiting alert signal is sent to the subscriber's computer station 112 that serves as a query for the subscriber to respond (col. 5, line 23 – col. 6, line 20).

The limitations "where the query includes a list of call disposition options for said telephone call" and "receiving a decision on the disposition of said telephone call from the called station" reads on Shtivelman '692 as follows. The subscriber decides to dispose of the waiting call by selecting from a list of options. For example, the subscriber can select to accept the call as an Internet call, select a prerecorded message to play to the caller, accept the call as a PSTN call, forward the call to selected numbers, or not to answer the call (col. 5, line 57 – col. 6, line 20).

Although Shtivelman '692 discloses the option of routing the incoming call to other telephone devices such as alternate or cellular telephones (col. 6, lines 1-20), Shtivelman '692 fails to specifically disclose that the list of call disposition options includes sending the telephone call to voicemail.

However, Norris '611 (similarly to Shtivelman '692) also teaches of an Internet call waiting system (abstract) that provides incoming call routing options such as the option to route the incoming call to voicemail (col. 5, lines 55-60).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the option of routing the incoming call to voicemail as taught by the Internet call waiting system with incoming call routing of Norris '611 to the routing options disclosed by the Internet call waiting system with incoming call routing disclosed by Shtivelman '692.

The suggestion/motivation for doing so would have been to increase the efficiency, flexibility, user-friendliness, and versatility of the income call routing system disclosed by Shtivelman '692 by allowing an incoming call to be routed to voice mail in cases where the called party would like to record a message from the incoming party but does not consider the call important enough to suspend current work and dedicate time to answer in real time as would have been notoriously well known in the art of call screening systems and common business

practices. Further, Shtivelman '692 discloses that the called party can select alternate routing options such as routing to a cellular telephone. It would have also been notoriously well known in the art that both telephones and cellular telephone are often coupled to voice messaging systems either locally (e.g., telephone answering devices) or at the network level (e.g., voice mail systems). Therefore, the simple act of routing the call to a telephone equipped with or subscribing to a voice messaging service would have provided an option to route to voicemail with very little structural modification required.

Claim 11 differs substantively from claim 1 in the following manner. Claim 11 recites that the call is forwarded to an intermediate server instead of an application server as in claim 1. However, the telephony switch (with IP interface) 141 is a server that is intermediately positioned between the caller and the Internet service provider (ISP) that the called party is using (Fig. 1 and col. 4, lines 55-60). In addition, claim 11 recites that the query is sent "via the Internet" and "request[s] a decision from a list of call disposition options" which reads on the ability of the subscriber, in response to the query sent via the Internet, to select from a plurality (list) of call disposition options as discussed in the claim 1 rejection above. Claim 11 also recites that the query to the called station is accompanied by a "calling station identification" which reads on col. 5, lines 53-56. Finally, claim 11 recites that the call disposition actions are performed which reads on col. 5, line 57 – col. 6, line 20.

Claim 23 differs substantively from claim 11 in that claim 23 recites that the forwarding occurs upon said called station launching "Internet connection software" instead of an Internet

connection as in claim 11. However, this limitation reads on col. 4, lines 55-65. Specifically, the client's computer dials up the Internet service provider (ISP). Therefore, the computer comprises Internet connection software that is launched to accomplish the dialing. The dialing string also contains the call forwarding command that causes the forwarding to occur. Therefore, the forwarding occurs upon the called station's computer launching the Internet connection software required to dial up the ISP.

With respect to claims 2-4, 6, 7, 12-14, 16, and 17, see the claim 1 rejection above for further details.

With respect to claims 8 and 18, the caller would be on hold while the caller is listening to a pre-recorded message.

With respect to claims 9 and 19, Shtivelman '692 fails to specifically disclose that the incoming call is routed to a conference bridge.

However, Norris '611 also teaches of an Internet call waiting system (abstract) that provides incoming call routing options such as the option to route the incoming call to a conference bridge (Fig. 8 and col. 8, lines 51-65).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the option of routing the incoming call to a conference bridge as

taught by the Internet call waiting system with incoming call routing of Norris '611 to the routing options disclosed by the Internet call waiting system with incoming call routing disclosed by Shtivelman '692.

The suggestion/motivation for doing so would have been to increase the flexibility, user-friendliness, and versatility of the income call routing system disclosed by Shtivelman '692 by allowing an incoming call to be conferenced such as in business environments where the ability to conference incoming calls is a standard and well-used feature. In addition, Norris '611 recognizes specifically that a conferencing feature would be an improvement over prior art Internet call-waiting systems (col. 2, lines 1-17) such as the system disclosed by Shtivelman '692.

With respect to claim 10 and 20, the called party can choose to answer the call (see the claim 1 rejection) and therefore has to option to hang-up.

With respect to claim 21, although Shtivelman '692 discloses that the incoming call is provided with caller ID information (see the claim 1 rejection above and col. 5, lines 53-56), Shtivelman '692 fails to specifically disclose that the caller ID information is stored, such as in a database.

However, an "Official Notice" was set forth in a prior Office action that both the concept and advantages of storing caller ID information when the called party chooses an option to

receive or process (such as routing to voicemail) the incoming call would have been well-known and expected in the art. This is especially the case in the art of call-logging and voice mail systems which both often use caller ID devices to store the incoming caller ID data for later retrieval, display, and/or screening purposes. However, the applicant's decision not to traverse the Official notice is taken as an admission of the fact(s) noticed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add the option to store caller ID information to the system that provided caller ID information for incoming calls as disclosed by Shtivelman '692.

The suggestion/motivation for doing so would have been to increase the versatility and user-friendliness of caller ID based systems by storing the caller ID data in a database for later retrieval and/or display such as when the called party is not present during incoming calls or when the called party wishes to document incoming calls. This is notoriously well known in the art of local, caller-ID devices and also well known in the art of screening and voice mail systems as well.

With respect to claims 22, 24, and 25, see col. 5, lines 40-67.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (703) 306-0377.



Roland G. Foster  
Primary Patent Examiner  
January 5, 2005